

PATENT
Application # 09/945,038
Attorney Docket # 1070-002

REMARKS

The Examiner is respectfully thanked for the consideration provided to this application. Reconsideration of this application is respectfully requested in light of the foregoing amendments and the following remarks.

Each of claims 5-12 has been cancelled without prejudice or disclaimer.

Each of claims 1 and 3 has been amended for at least one reason unrelated to patentability, including at least one of: to explicitly present one or more elements implicit in the claim as originally written when viewed in light of the specification, thereby not narrowing the scope of the claim; to detect infringement more easily; to enlarge the scope of infringement; to cover different kinds of infringement (direct, indirect, contributory, induced, and/or importation, etc.); to expedite the issuance of a claim of particular current licensing interest; to target the claim to a party currently interested in licensing certain embodiments; to enlarge the royalty base of the claim; to cover a particular product or person in the marketplace; and/or to target the claim to a particular industry.

Claims 1-4 are now pending in this application. Claim 1 is in independent form.

The Statutory Subject Matter Rejections

Each of claims 1-7 was rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter. Reconsideration and withdrawal of these rejections is respectfully requested. To support the rejections, the Office Action states that "[f]or a claimed invention to be statutory, the claimed invention must be within the technological arts". This statement is not currently correct, having been recently reversed by the USPTO. Please see the precedential Board opinion: *Ex parte Lundgren*, Appeal No. 2003-2088 (BPAI 2005).

To be patentable in the United States, a claimed invention does not have to "be within the technological arts". Consequently, reconsideration and withdrawal of the non-statutory subject matter rejection of each of claims 1-7 is respectfully requested.

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The Anticipation Rejections

Each of claims 1-7, 9 and 12 was rejected as anticipated under 35 U.S.C. 102(b). In support of the rejection, various portions of Papageorge (U.S. Patent No. 6,584,445) were applied. These rejections are respectfully traversed.

Papageorge fails to establish a *prima facie* case of anticipation. See MPEP 2131. To anticipate expressly, the “invention must have been known to the art in the detail of the claim; that is, all of the elements and limitations of the claim must be shown in a single prior art reference, arranged as in the claim”. *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383, 58 USPQ2d 1286, 1291 (Fed. Cir. 2001). The single reference must describe the claimed subject matter “with sufficient clarity and detail to establish that the subject matter existed in the prior art and that its existence was recognized by persons of ordinary skill in the field of the invention”. *Crown Operations Int’l, LTD v. Solutia Inc.*, 289 F.3d 1367, 1375, 62 USPQ2d 1917, 1921 (Fed. Cir. 2002). Moreover, the prior art reference must be sufficient to enable one with ordinary skill in the art to practice the claimed invention. *In re Borst*, 345 F.2d 851, 855, 145 USPQ 554, 557 (1965), *cert. denied*, 382 U.S. 973 (1966); *Amgen, Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1354, 65 USPQ2d 1385, 1416 (Fed. Cir. 2003) (“A claimed invention cannot be anticipated by a prior art reference if the allegedly anticipatory disclosures cited as prior art are not enabled.”) The USPTO “has the initial duty of supplying the factual basis for its rejection.” *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (1967).

Specifically, *inter alia*, claim 1, from which each of claims 2-4 depends, recites, yet Papageorge does not teach expressly or inherently:

without involving a medical professional:

providing, to the particular healthcare consumer, information relating to said previously diagnosed condition from at least one database, said information comprising, with respect to treating the previously diagnosed condition in other healthcare consumers, for **each**

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of a plurality of healthcare providers, a measure of the healthcare provider's charges and a measure of the healthcare provider's quality; receiving, from the particular healthcare consumer, a **plurality of criteria related to selecting a desired healthcare provider** to treat the previously diagnosed condition; and **identifying**, to the particular healthcare consumer, treatment options for said previously diagnosed condition, said identified treatment options comprising a **listing of the plurality of healthcare providers ranked according to one or more of the prioritized criteria**.

Instead, Papageorge allegedly discloses a "computerized health evaluation system for **joint patient and physician decision making** concerning particular medical diseases and conditions. The system includes a computer system with a patient input module for patient input of patient data concerning the patient's lifestyle and preferences, a **physician input module for physician input** of physical and physiological data, and a database of the latest medical findings concerning the particular disease and condition. The computer system uses an algorithm for weighing the patient data and the physician data in view of the database and generating a report setting forth various treatment options. **Based upon the report, the patient and physician will jointly decide on a treatment approach.**" See Abstract.

DeBruin-Ashton does not cure the deficiencies of Papageorge. Instead, DeBruin-Ashton allegedly discloses a "**directory of group physicians** for a health care provider service [...] in which the directory is tailored to a particular customer of the provider service. Relational databases of physician information, customer information, geographic mapping information, and images and/or advertising information are used to **select those physicians**, health care providers and health care businesses **that are local to a specific customer** and are to be printed in a directory for that customer. The selection of physicians from the database may include physicians having **specialties that had been used by the customer**, or physicians having

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specialties that correspond to the health care needs of a customer, e.g., customers having young children tend to use pediatricians. In addition, a mapping software program generates a local map for the customer that plots the addresses of the physician to be listed in the directory. The information extracted from databases regarding the customer, physicians, local map and other information is merged with a template directory to print a directory tailored to a particular customer."

Accordingly, it is respectfully submitted that the rejection of claim 1 is unsupported by Papageorge and should be withdrawn. Also, the rejection of each of claims 2-4, each ultimately depending from independent claim 1, is unsupported by Papageorge and also should be withdrawn.

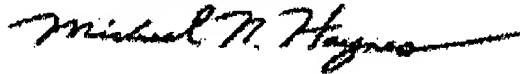
CONCLUSION

It is respectfully submitted that, in view of the foregoing amendments and remarks, the application as amended is in clear condition for allowance. Reconsideration, withdrawal of all grounds of rejection, and issuance of a Notice of Allowance are earnestly solicited.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. 1.16 or 1.17 to Deposit Account No. 50-2504. The Examiner is invited to contact the undersigned at 434-972-9988 to discuss any matter regarding this application.

Respectfully submitted,

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